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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,150	12/15/2003	Osamu Nagai	13712	3663
7590 ORUM & ROTH 53 W. JACKSON BLVD CHICAGO, IL 60604		09/03/2008	EXAMINER BURCH, MELODY M	
			ART UNIT 3683	PAPER NUMBER
			MAIL DATE 09/03/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/736,150

Applicant(s)

NAGAI, OSAMU

Examiner

Melody M. Burch

Art Unit

3683

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/16/08, 8/27/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 1,3,5,7,9,11 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,4,6,8,10,12 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/16/08 has been entered.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation of one shock absorber exclusively damping during compression and the other shock absorber exclusively damping during expansion as recited in claims 2 and 14 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The originally filed specification fails to provide support for the phrase "except for unintended frictional effects, exclusively" in claims 2 and 14.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 2, 4, 6, 8, 10, 12, and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In lines 3-4 of claim 2 and in lines 4-5 of claim 14 the phrase "except for unintended frictional effects, exclusively" does not enable one to make and/or use the invention in light of the drawings and portions of the originally filed specification. Although paragraph [0051] of the published application states "dampened by the compression side damping force generated by the compression side damping force generating means 101 of the hydraulic shock absorber 100 in the compression stroke, and by the expansion side damping force generated by the expansion side damping force generating means 201 of the hydraulic shock absorber 200 in the expansion stroke", the drawings as well as other paragraphs of the published application suggest that the shock absorbers do not have, except for unintended frictional effects, *exclusive* damping characteristics as claimed. For example, compression side damping force generating structure 101 shows both a check valve 43 for damping flow resulting from compression strokes as described in paragraph [0031] and a check valve 44 for damping flow resulting from expansion strokes as described in paragraph [0034]. Similar illustrations and descriptions exist for the expansion side

damping force generating structure. In light of the illustrations and various sections of the specification supporting non-exclusive compression and expansion damping, the description does not enable one to make or use the exclusive damping aspect of the claimed invention. The remaining claims are rejected due to their dependency from claim 2.

6. Claims 2, 4, 6, 8, 10, 12, and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The inclusion of the limitation of "the check valve when opened arranged to prevent damping" in lines 3-4 from the bottom of claim 2, for example, raises new matter. Because it is known in the art to have a check valve that provides damping, Examiner maintains that the language precluding the damping function of check valves needed to have been presented in the originally filed disclosure to avoid 112 rejections for new matter. Please note check valve 44 in US Patent 7354363 to Foster et al. and check valve 52 in US Patent 5787932 to Pierce, examples used to support the Examiner's position.

Allowable Subject Matter

7. Claims 2, 4, 6, 8, 10, 12, and 14 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action.

Information Disclosure Statement

8. The information disclosure statement filed 1/22/08 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. Foreign patent document numbers have been listed in the IDS, but only the English abstracts of the documents have been provided. JP-6441495 was not lined through because it was previously considered in the IDS of 2/27/04.

Response to Arguments

9. Applicant's arguments filed 7/16/08 have been fully considered but they are not persuasive.

The inclusion of the limitation of "the check valve when opened arranged to prevent damping" raises new matter. Applicant argues that "[t]he purpose of check valves is widely known and accepted to be valves which to the extent possible under non-ideal conditions allow fluid to flow freely in one direction, and to stop altogether fluid flow in the opposite direction." Applicant also argues that Lohr may not understand the terms "check valve" and "damping valve" correctly. Examiner notes that if it is "widely known and accepted" that check valves allow flow freely in one direction, then it is reasonable to turn to the art in order to see how check valves are used. Examiner already presented the Lohr reference which used the terms check valve and damping valve

interchangeably, suggesting that the check valve also serves as a damping valve.

Examiner further presents instances in the art where it is expressly stated that the check valve provides damping. Please note check valve 44 in US Patent 7354363 to Foster et al. and check valve 52 in US Patent 5787932 to Pierce. Because it is known in the art to have a check valve that provides damping, Examiner maintains that the language precluding the damping function of check valves needed to have been presented in the originally filed disclosure to avoid 112 rejections.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 571-272-7114. The examiner can normally be reached on Monday-Friday (6:30 AM-3:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Siconolfi can be reached on 571-272-7124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mmb
September 1, 2008

/Melody M. Burch/
Primary Examiner, Art Unit 3683